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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,100	11/26/2001	Kenneth A. Hill SR.	071554.0102	2510
26231	7590	05/04/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			KOPPIKAR, VIVEK D	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/996,100	Applicant(s) HILL ET AL.	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-28 have been examined in this application. This is a Final Office Action. The IDS (Information Disclosure Statement) statement filed on January 18, 2006 has also been acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bass.

(A) As per claim amended claims 1 and 5, Feeney teaches a pharmacy prescription processing subsystem (Feeney: Sections [0177]); and

a central fill prescription processing subsystem coupled to the first pharmacy prescription processing subsystem and a second pharmacy subsystem by a transmission medium, said pharmacy prescription processing subsystem operable to (Feeney: Sections [0176]-[0177] and [0181]) (Note: Feeney teaches that more than one subsystem can communicate with the central fill prescription processing subsystem (24));

receive a plurality of prescription requests (Feeney: Sections [0177]);

create a queue of prescription requests from said received plurality of prescription requests, each prescription request in said queue eligible to be filled by a central fill inventory

Art Unit: 3626

(Feeney: Sections [0177] and [0228]);

transmit said converted queue of prescription requests to said central fill prescription processing subsystem by said transmission medium, said central fill prescription processing subsystem operable to (Feeney: Sections [0177] and [0228]):

receive said converted queue of prescription requests with said transmission format (Feeney: Section [0183]);

convert said queue of prescription requests from said transmission format to a processing format (Feeney: Section [0183]);

fill a plurality of prescription requests in said queue of prescription requests from said central fill inventory (Feeney: Sections [0182]-[0184]); and

dispense a plurality of drugs from said central fill inventory, said dispensed plurality of drugs associated with said plurality of filled prescription requests (Feeney: Sections [0182]-[0185]).

Feeney does not teach the step of converting the queue of the prescription requests to a transmission format, however, this feature is well known in the art as evidenced by Bass (Bass: Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17). As per claim 5, in the combined system of Feeney in view of Bass the network operates is a TCP/IP network (Bass: Col. 2, Ln. 14-17).

(B) As per claims 2-4 and 8, these claims are rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

Art Unit: 3626

(C) As per claims 9 and 11, Feeney pharmacy prescription processing system (Feeney: Abstract), comprising: means for entering a prescription request (Feeney: Section [0177]); and a processor coupled to said means for entering (Feeney: Section [0177]), said processor operable to: receive a plurality of prescription requests (Feeney: Section [0177]); create a queue of prescription requests from said received plurality of prescription requests, each prescription request in said queue eligible to be filled by a central fill inventory (Feeney: Section [0177] and [0228]); and transmit the queue of prescription requests to a central fill prescription processing system that dispenses a plurality of drugs from the central fill inventory based, at least in part, on the transmitted queue of prescription requests (Feeney: Section [0183]-[0185] and Figure 1—Number (24))). Feeney does not teach the means of converting the queue of the prescription requests to a transmission format, however, this feature is well known in the art as evidenced by Bass (Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

(D) As per claims 10 and 12, these claims are rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

(E) As per claim 13, Feeney teaches a method for processing prescription requests (Feeney: Abstract), comprising the steps of:

a pharmacy prescription processing subsystem receiving a plurality of prescription requests, at least one of the prescription requests from a physician and at least one of the

Art Unit: 3626

prescription requests received from a patient (Feeney: Sections [0177] and [0181] and Figure 1—Number (44));

creating a queue of prescription requests from said received plurality of prescription requests, each prescription request in said queue eligible to be filled by a central fill inventory (Feeney: Sections [0177] and [0228]);

transmitting said converted queue of prescription requests to a central fill prescription processing subsystem (Feeney: Sections [0177] and [0228]);

said central fill prescription processing subsystem receiving said converted queue of prescription requests (Feeney: Section [0177]);

filling a plurality of prescription requests in said queue of prescription requests from said central fill inventory (Feeney: Sections [0182]-[0185]); and

dispensing a plurality of drugs from said central fill inventory, said dispensed plurality of drugs associated with said plurality of filled prescription requests (Feeney: Sections [0182]-[0185]).

Feeney does not teach the step of converting the queue of prescription requests to a transmission format and converting said queue of prescription requests from said transmission format to a processing format, however, these features are well known in the art as evidenced by Bass (Bass: Col. 7, Ln. 41-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Feeney with the aforementioned feature from Bass with the motivation of providing a means of converting information into a format acceptable by a network, as recited in Bass (Bass: Col. 2, Ln. 14-17).

Art Unit: 3626

(F) As per claims 14-16 and 18, these claims are rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

4. Claims 19-20, 22-23 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bodmer and in further view of Renz.

(A) As per claim 19, Feeney teaches a method of processing prescription requests (Feeney: Abstract), comprising the steps of:

entering at least a first prescription request into a queue of prescription requests to be filled (Feeney: Section [0177]);

if said at a first prescription request can be filled by said brand name drug from said central fill inventory, assigning said brand name drug to fill said at least one prescription request (Feeney: Section [0177]);

if said at least a first prescription request has been assigned for filling from said central fill inventory, sending said prescription fill queue including said at least one prescription request to a dispensing system associated with said central fill inventory for filling (Feeney: Section [0177]).

Feeney does not teach the steps of determining if said at least one prescription request is eligible to be filled from a central fill inventory; if said at least one prescription request is eligible to be filled from said central fill inventory, determining if said at least one prescription request can be filled by a brand name drug from said central fill inventory; and if said at least one prescription request is not eligible to be filled from said central fill inventory, assigning said at least one prescription request to be filled from a local inventory, however these features are

Art Unit: 3626

taught in Bodmer (Section [0039]). At the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the method of Feeney with the aforementioned features from Bodmer with the motivation of developing an improved electronic prescription system to seamlessly incorporate products and services from third parties (various sources) into on e-commerce site, as recited in Bodmer (Section [0033]).

The combined system of Feeney in view of Bodmer does not teach the steps of if said at least one prescription request cannot be filled by a brand name drug from said central fill inventory, determining if a second drug from said central fill inventory can be substituted for said brand name drug; and if said at least one prescription request can be filled by a second drug from said central fill inventory, assigning said second drug to fill said at least one prescription request; if said at least one prescription request cannot be filled by a second drug from said central fill inventory, assigning said at least one prescription request to be filled from said local inventory; however, these features are well known in the art as evidenced by Renz (Section [0017]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Feeney in view of Bodmer with the aforementioned features from Renz with the motivation of providing a means of adapting a supply chain network to environmental changes without compromising on operation and financial efficiencies (ensuring that a customer's order is satisfied efficiently), as recited in Renz (Section [0009]).

(B) As per claims 20 and 22-23, these claims are rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

Art Unit: 3626

(C) As per claims 27-28, in the method of Feeney the first prescription request can be requested by either a prescriber (doctor) or customer (patient) (Feeney: Figure 1—Numbers (14, 24 and 44), Sections [0043] and [0176]-[0181]).

5. Claim 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bass, as applied to Claims 1 and 13, above, respectively and in further view of Munoz.

(A) As per claims 6 and 17, these claims are rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bass and in further view of PDXinc.com (published on August 3, 2001).

(A) As per claim 7, this claim is rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of Bodmer and Renz and in further view of Takahashi.

(A) As per claim 21, this claim is rejected in the same manner as set forth in the Office Action dated January 9, 2006 which is incorporated herein by reference to the present Office Action.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feeney in view of US Patent Application Publication to 2002/0038259 to Bergman.

(A) As per claim 24, Feeney teaches a method of processing prescription request (Feeney: Abstract), comprising the steps of:

receiving a plurality of prescription requests to be filled from a pharmacy (Feeney: Section [0177] and Figure 1—Number (24));

selecting at least one prescription request from said plurality of prescription requests (Feeney: Section [0228]);

if the central fill inventory has adequate inventory to fill said at least one prescription request, allocating a dispense quantity for said at least one prescription request (Feeney: Section [0177] and [0228]);

if a dispense quantity has been allocated for said at least one prescription request, dispensing said dispense quantity from said central fill inventory (Feeney: Sections [0182]-[0184]).

Feeney does not teach the steps of determining if a central fill inventory has adequate inventory to fill said at least one prescription request; if said central fill inventory has inadequate inventory to fill said at least one prescription request, generating an error message to report that said central fill inventory has inadequate inventory to fill said prescription request; however, these feature are well known in the art as evidenced by Bergman (Section [0038]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Feeney with the aforementioned steps from Bergman with the motivation of providing a user with a means of notification if an order cannot be fulfilled.

(B) As per claim 25, in the combined method of Feeney in view of Bergman, the method comprises the steps of initiating an order pull for said plurality of prescription requests (Feeney: Section [0177]), said plurality including said at least one prescription request having an allocated

Art Unit: 3626

dispense quantity (Feeney: Sections [0182]-[0184]); generating at least one packing slip associated with said order pull (Feeney: Section [0234]); and

substantially affixing said at least one packing slip to a tote, said tote including said dispensed

quantity from said central fill inventory, and said tote destined for a predetermined store (Feeney: Section [0234]).

(C) As per claim 26, in the combined system of Feeney in view of Bergman initiating an order pull for said plurality of prescription requests, said plurality including said at least one prescription request having an allocated dispense quantity (Feeney: Section [0177]); and

generating a summary manifest report including a plurality of orders associated with said order pull (Feeney: Section [0042]).

Response to Arguments

8. Applicant's arguments filed on April 18, 2006 have been fully considered but they are not persuasive. The arguments will be addressed in sequential order as they were presented in the "Remarks" section.

Applicants argue that Feeney does not teach a central system that dispenses a plurality of drugs from central fill inventory, however, Feeney in does in fact show this feature (Figure 1 and Sections [0176]-[0177]). Even though the preferred embodiment is that the system of dispensing medication and information is located at the point of service, Feeney teaches that the dispenser can take many forms (Feeney: Sections [0184]-[0187]). The central dispenser taught in Feeney does in fact dispense medicines (Feeney: Section [0186]).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either

Art Unit: 3626

Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

Vivek Koppikar



4/28/2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER